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EXAMINER

HUANG, TSAN-YU J

ART UNIT

PAPER NUMBER

3685

MAIL DATE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/572,693	Applicant(s) HINRICHS ET AL.	
	Examiner TSAN-YU JAY HUANG	Art Unit 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16, 18, 19 and 21-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16, 18, 19 and 21-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

This Office Action is in response to the original application filed on June 15, 2009.

The Examiner notes that United States Patent Application Publication paragraph numbers in the Office Action will be referred to as [#####], ##### representing the paragraph number.

The Examiner notes that an ellipsis (...) marks an intentional omission of a phrase from the original text, and is not shorthand for the actual phrase.

The Examiner notes that the usage of "etc" marks a continuation of the phrase from the original text.

Status of Claims

Claims 16, 18-19, 21-45 are currently pending and have been examined.

Claims 16, 18-19, 21-45 are rejected as set forth below.

Response to Arguments

Applicant's argument #1

Applicant contends **claims 16-31** are obviated of the 35 USC § 101 rejection set forth in the previous Office Action.

Examiner's response #1

Applicant's arguments, see Applicant's argument #1, with respect to claims 16-31 have been fully considered and are persuasive. The rejection has been withdrawn.

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Applicant's argument #2

Applicant contends **claims 16-31** are obviated of the 35 USC § 112, second paragraph rejections (definition of system) set forth in the previous Office Action.

Applicant contends **claims 17-18, 21-26, 28-29** are obviated of the 35 USC § 112, second paragraph rejections (hybrid claim, indefinite) set forth in the previous Office Action.

Examiner's response #2

Applicant's arguments, see Applicant's argument #2, with respect to claims 16-31 have been fully considered and are persuasive. The rejection (definition of system) has been withdrawn.

Applicant's arguments, see Applicant's argument #2, with respect to claims 17-18, 21-26, 28-29 have been fully considered and are persuasive. The rejection (hybrid claim, indefinite) has been withdrawn.

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Applicant's argument #3

Applicant contends **claims 16-20, 23, 27, 30-31** are not unpatentable under the 35 USC § 102 rejections (*Meunier*) set forth in the previous Office Action.

Examiner's response #3

Applicant's arguments with respect to claims 16-20, 23, 27, 30-31 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 32-45** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

3. **Regarding claim 32**, the invention is rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008). An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being

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transformed. In this particular case, claim 32 fails prong (1) because the limitation “exchanging information, etc” is extra-solution activity. Furthermore, the limitations are not tied to positively recited statutory classes. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing. The rejection applies to dependent **claims 33-45.**

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claims 16, 18-19, 21-31** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. **Regarding claim 16**, the invention purports to be both a product or machine and a process and therefore is ambiguous. It has been held that a claim that recites both an apparatus and a method for using said apparatus is indefinite under section 112, paragraph 2, as such a claim is not sufficiently precise to provide competitors with an accurate determination of the 'metes and bounds' of protection involved. For example, the limitations "transportation requests, which are communicated to the server", "transportation offerings, which are communicated to the server", and "interested parties that communicated the matching request" are method steps that do not pertain to the functionality of the server. See *MPEP 2173.05(p) II; IPXL Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (CA FC 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990). The rejection applies to dependent **claims 18-19, 21-31**.

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Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 16, 18-19, 23-27, 29-34, 37-41, 43-45** are rejected under 35

U.S.C. 103(a) as being unpatentable over United States Patent Application Publication No. 2002/0186144 to *Meunier*.

9. **Regarding claims 16 and 32**, *Meunier* teaches:

A system for procuring a service, comprising:

at least one stationary physical server; ([0062])

a plurality of devices accessible to subscribers including at least one device accessible to suppliers and at least one device accessible to interested parties; ([0032]; [0059] – [0062])

a communications arrangement that enables at least an information exchange between the at least one server and the devices accessible to subscribers; ([0061] – [0062], [0105] – [0113]; [0167] – [0179]; [0191] – [0197])

a positioning arrangement for determining a current position of the devices accessible to

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subscribers; ([0113]) and

a memory for at least temporarily storing data corresponding to position and route information of the subscribers. ([0132] – [0137])

wherein the at least one server is configured to compare transportation requests, which are communicated to the server from at least one device accessible to interested parties, to transportation offerings, which are communicated to the server from at least one device accessible to suppliers, ([0191] – [0200]; [0217] – [0220])

wherein the at least one server is configured to determine whether any transportation requests match any transportation offerings, and to communicate the match to the device accessible to interested parties that communicated the matching request if there is a match; ([0191] – [0200]; [0217] – [0220]) and

Furthermore, a recitation of the intended use of the claimed invention (i.e. the at least one server configured to perform an action) must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967).

Meunier does not explicitly teach intermediate route information.

However, Applicant attempts to further limit the system by describing characteristics of the transportation offerings. However, this is representative of non-functional descriptive material as characteristics of the transportation offerings is not functionally related to the system (MPEP 2106 II; *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994)) and therefore cannot be used to differentiate Applicant's invention from the prior art invention.

10. **Regarding claims 18 and 33**, *Meunier* discloses the invention as claimed. See the discussion of claim 16.

Meunier further teaches “wherein the server is configured to establish a communication link between the device accessible to suppliers that communicated the matching offering and the device accessible to interested parties that communicated the matching request if there is a match.” ([0172] – [0175])

Furthermore, a recitation of the intended use of the claimed invention (i.e. the at least one server configured to perform an action) must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967).

11. **Regarding claims 19 and 34**, *Meunier* discloses the invention as claimed. See the discussion of claim 16.

Meunier further teaches “wherein the positioning arrangement is configured to determine the current position of the devices accessible to subscribers in real time.” ([0113])

Furthermore, a recitation of the intended use of the claimed invention (i.e. the at least one server configured to perform an action) must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967).

12. **Regarding claims 23 and 37**, *Meunier* discloses the invention as claimed. See the discussion of claim 16.

Meunier further teaches “wherein the transportation offerings are provided in the form of one of a list and a map display containing time information.” ([0197])

Furthermore, Applicant attempts to further limit the system by describing characteristics of the transportation offerings. However, this is representative of non-functional descriptive material as characteristics of the transportation offerings is not functionally related to the system (MPEP 2106 II; *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994))

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and therefore cannot be used to differentiate Applicant's invention from the prior art invention.

13. **Regarding claims 24 and 38**, *Meunier* discloses the invention as claimed. See the discussion of claim 16.

Meunier further teaches “wherein the server is configured to notify at least one device accessible to a subscriber if a supplier has reached a certain position.” ([0217] – [0220])

Furthermore, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967).

14. **Regarding claims 25 and 39**, *Meunier* discloses the invention as claimed. See the discussion of claim 16.

Applicant attempts to further limit the system by describing characteristics of the transportation request. However, this is representative of non-functional descriptive material as characteristics of the transportation request is not functionally related to the system (MPEP 2106 II; *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994)) and therefore cannot be used to differentiate Applicant's invention from the prior art invention.

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15. **Regarding claims 26 and 40**, *Meunier* discloses the invention as claimed. See the discussion of claim 16.

Applicant attempts to further limit the system by describing characteristics of the transportation offering. However, this is representative of non-functional descriptive material as characteristics of the transportation offering is not functionally related to the system (MPEP 2106 II; *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994)) and therefore cannot be used to differentiate Applicant's invention from the prior art invention.

16. **Regarding claims 27 and 41**, *Meunier* discloses the invention as claimed. See the discussion of claim 16.

Applicant attempts to further limit the system by describing characteristics of the transportation offerings/requests. However, this is representative of non-functional descriptive material as characteristics of the transportation offerings is not functionally related to the system (MPEP 2106 II; *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994)) and therefore cannot be used to differentiate Applicant's invention from the prior art invention.

17. **Regarding claims 29 and 43**, *Meunier* discloses the invention as claimed. See the discussion of claim 16.

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Meunier further teaches “wherein the server is configured to offer a selection list including alternate transportation offerings to at least one device accessible to interested parties.” ([0234] – [0242])

Furthermore, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967).

18. **Regarding claims 30 and 44**, *Meunier* discloses the invention as claimed. See the discussion of claim 16.

Meunier further teaches “a memory for storing parameters identifying the suppliers and the interested parties.” ([0132] – [0137], the central computer server contains memory)

19. **Regarding claims 31 and 45**, *Meunier* discloses the invention as claimed. See the discussion of claim 16.

Meunier further teaches “wherein the service includes one of a rideshare opportunity and a transportation service.” (Abstract, the service is a transportation service)

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20. **Claims 21-22, 28, 35-36, 42** are rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent Application Publication No. 2002/0186144 to *Meunier*, in view of United States Patent No. 5,799,263 to *Culbertson*.

21. **Regarding claims 21, 35**, *Meunier* discloses the invention substantially as claimed. See the discussion of claim 16.

Meunier does not explicitly teach “wherein the server is configured to combine transportation offerings communicated from multiple devices accessible to suppliers to offer an interested party an uninterrupted route.”

However, *Culbertson* teaches combining transportation offerings. (column 6 lines 9-59)

One of ordinary skill in the art at the time of the invention would have been motivated to modify *Meunier* with the features taught by *Culbertson* because modifying the invention to combine transportation offerings allows an otherwise impossible request to be satisfied.

22. **Regarding claims 22, 36**, *Meunier* discloses the invention substantially as claimed. See the discussion of claim 16.

Meunier does not explicitly teach “wherein the server is configured to determine projected arrival times for positions of a route and communicate the projected arrival times to at least one device accessible to subscribers.”

However, *Culbertson* teaches determining and communicating the projected arrival time. (column 7 lines 48-62)

One of ordinary skill in the art at the time of the invention would have been motivated to modify *Meunier* with the features taught by *Culbertson* because modifying the invention to determine and communicate the projected arrival time increases convenience to the consumer.

23. **Regarding claims 28, 42,** *Meunier* discloses the invention substantially as claimed. See the discussion of claim 16.

Meunier does not explicitly teach “wherein the server is configured to offer a transportation option using a public means of transportation to at least one device accessible to interested parties”

However, *Culbertson* teaches offering a public means of transportation. (column 5 line 60 – column 6 line 59)

One of ordinary skill in the art at the time of the invention would have been motivated to modify *Meunier* with the features taught by *Culbertson* because modifying the invention offer a public means of transportation allows an alternative form of transportation, thus increasing the options a consumer can choose from.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

The reference *Chase* (United States Patent Application Publication No. 2003/0034873) discloses a method and system for an automated car sharing system.

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to TSAN-YU JAY HUANG whose telephone number is (571)270-7039. The examiner can normally be reached on Monday to Friday, 9:00 am - 5:00 pm Eastern Standard Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L. Hewitt, II can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/TSAN-YU J HUANG/
Examiner, Art Unit 3685
November 3, 2009

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685